

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

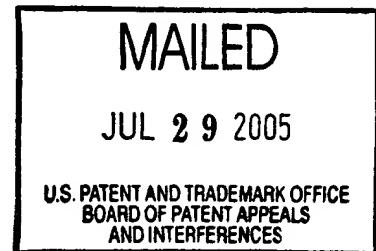
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte PAUL J. BRUINSMA,
SURESH BASKARAN,
JAGANNADHA R. BONTA and JUN LIU

Appeal No. 2005-1297
Application No. 09/481,988

ON BRIEF



Before OWENS, DELMENDO and JEFFREY T. SMITH, Administrative Patent Judges.
JEFFREY T. SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the Examiner's refusal to allow claims 188 and 189. The remaining claims 129 through 187 have been indicated as containing allowable subject matter by the Examiner. (Answer, p. 3). We have jurisdiction under 35 U.S.C. § 134.

Claim 188 is illustrative of the claims on appeal and is reproduced below:

188. A calcined mesoporous silica film on a substrate formed by a process comprising:
dispensing an acid catalyst- and silica precursor- and aqueous solvent- and surfactant-containing solution on the substrate;
forming a film on the substrate by rapid evaporation of the solution on the substrate;
heating the film on the substrate for a time and to a temperature sufficient substantially to remove any residual solvent; and
calcining the film at a temperature at or above 350°C.

The Appellants' invention relates to mesoporous thin films and structures.

The mesoporous thin films and structures are produced by a process of combining a precursor with a solvent, a catalyst and a surfactant and either forming them into a preform or dispensing the precursor onto a substrate. The solvent is then evaporated and the resulting film is heated. The heating may be at a temperature high enough to cause the film to become calcined. (Brief, p. 2).

Claims 188 and 189 stand rejected under 35 U.S.C. § 251 for failing to specify an error correctable by reissue. (Answer, pages 2-6).

BACKGROUND

The original patent, U.S. 5,922,299, issued on July 13, 1999 with claims 1-27. This patent was based on application serial number 08/921,754¹ which was filed on September 26, 1997, containing claims 1 to 28. In the office action mailed

¹ Application 08/921,754 is a continuation-in-part of application 08/753,573, filed November 26, 1996, abandoned January 26, 1988.

February 20, 1998, the Examiner restricted the claimed subject matter into three groups. Specifically, Group I, claims 1-24 drawn to a method of making mesoporous silica articles by forming, Group II, claims 25 and 26 drawn to a mesoporous silica product and Group III, claim 28 drawn to a mesoporous silica film on a substrate.² The Appellants traversed the election requirement. However, they elected to prosecute the claimed subject matter drawn to a method of making mesoporous silica articles by forming, i.e., the Group I invention.³ (Response filed March 16, 1998). The Examiner rejected the elected claims in the Office action mailed April 23, 1998.⁴ Appellants filed a response on October 13, 1998, amending some claims, adding claims 30 to 32 and canceling the non-elected claims 25 to 28. Subsequently, on October 21, 1998, the Examiner

² Claims 25-28 are reproduced below:

25. A mesoporous silica powder having a plurality of particles comprising: said plurality of particles in a size range are hollow spheres with mesopores therein.

26. The particles as recited in claim 25, having a diameter of at least 1 micron.

27. A mesoporous silica product, comprising: a fiber having a diameter of at least 5 microns with mesopores therein.

28. A calcined mesoporous silica film on a substrate comprising a d-spacing less than 40 angstroms.

³ Appellants also notified the Examiner that a preliminary amendment was filed wherein claim 17 was canceled and claim 29 was added. Appellants also asserted that the subject matter of claim 29 was drawn to the same invention as Group I.

⁴ The Examiner indicated that the claims 1 to 24 were subject to the rejection. However, in the reply filed October 13, 1998, Appellants acknowledged that claim 29 was also subject to the rejection. Neither paper recognized that claim 17 was canceled.

indicated that the subject matter of claims 1 to 16, 18 to 24 and 29 to 32 was allowable. No other continuation or divisional applications were filed based on application 08/921,754.

According to Appellants, Brief pages 3-4, the present reissue application was filed on January 20, 2000. Appellants prosecuted the application until a request for continuing application (RCE) was filed on April 9, 2001 and another RCE was filed on March 27, 2002. On October 6, 2003, a final office action was mailed, in which claims 129-187 were allowed, and claims 188 and 189 were rejected. This is the final office action to which Appellants responded by filing a notice of appeal, which is the instant appeal.

The Appellants appeal the Examiner's rejection of claims 188 and 189 under 35 U.S.C. § 251 for failing to specify an error correctable by reissue. According to the Examiner, the subject matter of claims 188 and 189 is the same patentable invention as the cancelled, non-elected claim 28 of the parent application.

We have carefully reviewed the claims, specification and related applications including all of the arguments advanced by both the Examiner and Appellants in support of their respective positions. This review leads us to conclude that the Examiner's rejection under 35 U.S.C. § 251 is well founded.

Rather than reiterate the conflicting viewpoints advanced by the Examiner and the Appellants regarding the above-noted rejection, we make reference to

Appellants' Brief filed February 05, 2004, Reply Brief filed June 02, 2004 and the Examiner's Answer mailed April 02, 2004.

DISCUSSION

Appellants argue that the subject matter of claims 188 and 189 are part of the same patentable invention as the allowed process claims and not the same patentable invention as non-elected claim 28 from the parent application.

Specifically, Appellants state:

Upon inspection of claim 28 above and claims 188 and 189 set forth in the Appendix [of the Brief], it becomes clear that the subject matter of these claims is very different. Claim 28 claims a calcined, mesoporous thin film having a certain d-spacing. Claims 188 and 189 are directed to calcined, mesoporous thin films produced by a particular and very specific process.

...

Regardless of the Examiner's interpretation of the term calcining, it is apparent that the films claimed in claims 188 and 189 are vastly different subject matter than the film claimed in non-elected claim 28. Claim 28 was directed to a calcined, mesoporous thin, film having a particular d-spacing. Claims 188 and 189 are directed to a calcined, mesoporous thin film manufactured by a particular process, and the process is the subject matter of already-allowed claims.
(Brief, pp. 6-7).

As stated above, Appellants argue that claims 188 and 189 are part of the same patentable invention as the allowed process claims. Specifically, Appellants argue that "claims 188 and 189 are analogous to the [allowed] process claim 156 and similar to the process claim 159. Claim 159, when combined with its dependent claim 163, results in a mesostructured film that is calcined. Claim 188

and 189 merely claim the film formed by those processes. As stated above this is permissible and part of the same invention as the allowed process claims, not the invention that was restricted out in the parent case." (Brief, p. 7). In support of this position Appellants refer to MPEP § 2173.05(p). (Brief, p. 7).

The Appellants' arguments are not persuasive. It is acknowledged by Appellants that the subject matter of the appealed claims 188 and 189 is described in "product-by-process" format. (Brief, p. 7). A product may be defined by the process by which it is made. Where the product is defined by setting forth the process by which it is made, "the invention so defined is a product and not a process." *In re Bridgeford*, 357 F.2d 679, 682, 149 USPQ 55, 58 (CCPA 1966). (The issue before the court was whether there was same-invention double patenting between product claims and product-by-process claims. The CCPA held that there was. The court explained that product-by-process claims are claims to the product unlimited by the process steps in the claim: the invention so defined [by the product-by-process claim] is a *product* and not a *process*.). Thus, the subject matter of claims 188 and 189 is directed to a product.

The quoted portion of MPEP 2173.05(p) states "There are many situations where claims are permissibly drafted to include a reference to more than one statutory class of invention. A product-by-process claim, which is a product claim that defines the claimed product in terms of the process by which it is made, is proper." *In re Moeller*, 117 F.2d 565, 48 USPQ 442 (CCPA 1941). . . (emphasis

added). While the subject matter of claims 188 and 189 utilizes process limitations to describe the invention, the claimed subject matter is a product. Thus, contrary to Appellants' argument, the subject matter of claims 188 and 189 is not part of the same invention as the allowed process claims.

The Examiner asserts that the subject matter of claims 188 and 189 is the same patentable invention as claim 28 from the parent application. As stated above the subject matter of claims 188 and 189 is directed to a product. Likewise, the subject matter of non-elected claim 28 is directed to a product. Thus, the subject matter of these claims are part of the same statutory class of invention. However, belonging to the same statutory class of invention does not necessarily indicate that the claims are substantially identical in terms of scope. Regarding the product of non-elected claim 28 the Examiner asserted that "the generic substrate may be coated by chemical vapor deposition, brushing, immersion in a container with the coating of silica material."⁵ The record does not indicate that the scope of the cancelled, non-elected claim 28 and the scope of claims 188 and 189 are necessarily the same. The Examiner has not directed us to evidence that establishes that the subject matter of claim 28 is necessarily substantially identical to claims 188 and 189.

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Page 3 of the office action paper number 3, mailed February 20, 1998, from application 08/921,754.

We now look to relevant legal principles to review the Examiner's rejection under 35 U.S.C. § 251.

Our reviewing court has made it clear that section 251 "not every event or circumstance that might be labeled 'error' is correctable by reissue." *In re Weiler*, 790 F.2d 1576, 1579, 229 USPQ 673, 675 (Fed. Cir. 1986). As often stated by the court, the reissue procedure does not entitle a patentee to "prosecute *de novo* his original application." *Hester Industries Inc. v. Stein Inc.*, 142 F.3d 1472, 1479, 46 USPQ2d 1641, 1647 (Fed. Cir. 1998) (*quoting Weiler*, 790 F.2d at 1582, 229 USPQ at 677 and *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 995, 27 USPQ2d 1521, 1524 (Fed. Cir. 1993)).

Where a restriction requirement was made in an application and applicant permitted the elected invention to issue as a patent without the filing of a divisional application on the non-elected invention(s), substantially identical claims as the non-elected invention(s) cannot be recovered by filing a reissue application. A reissue applicant's failure to timely file a divisional application covering the non-elected invention(s) in response to a restriction requirement is not considered to be error causing a patent granted on the elected claims to be partially inoperative by reason of claiming less than the applicant had a right to claim. Accordingly, such error is not correctable by reissue of the original patent under 35 U.S.C. 251. *In re Watkinson*, 900 F.2d 230, 14 USPQ2d 1407 (Fed. Cir. 1990); *In re Orita*, 550 F.2d 1277, 1280, 193 USPQ 145, 148 (CCPA 1977). In this situation, the reissue claims should be rejected

under 35 U.S.C. 251 for lack of defect in the original patent and lack of error in obtaining the original patent. Compare with *In re Doyle*, 293 F.3d 1355, 63 USPQ2d 1161 (Fed. Cir. 2002) where the court permitted the patentee to file a reissue application to present a so-called linking claim, a claim broad enough to read on or link the invention elected (and patented) together with the invention not elected.

In *Orita*, the Court of Customs and Patent Appeals addressed whether failure to file a divisional in response to a restriction requirement is an error redressable by reissue. The applicant in *Orita* agreed to the restriction requirement and cancelled the non-elected claims. Then, following issuance of the patent on the elected claims, he filed an application for reissue on claims substantially identical to the originally non-elected claims. *In re Orita*, 550 F.2d at 1278, 193 USPQ at 147. The Board upheld the examiner's rejection of the reissue claims, and the court affirmed, holding that the "error" of failing to file a divisional on the non-elected groups was wholly irrelevant to the question whether any error was present in the patent that issued on the elected claims. The court agreed with the Board that while "appellants undoubtedly erred by failing to file a timely divisional application in order to obtain a divisional patent," *id.* at 1280, 193 USPQ at 148, the patent that issued on their elected claims was error-free. The court also rested its decision on the ground that the patentee knowingly acquiesced in the restriction requirement and that such acquiescence, because it is by definition not inadvertent, cannot be error for purposes of the reissue statute. *Id.* This is the *Orita* doctrine which precludes a reissue applicant from

obtaining substantially identical claims to those of non-elected groups identified in an examiner's restriction requirement when such claims could not have been prosecuted in the application from which they were restricted.

In *Watkinson* the applicant acquiesced during prosecution to a two-way restriction requirement. The applicant cancelled the non-elected claims and never filed a divisional application on the non-elected group. Following issuance of the patent on the elected claim, the applicant filed a reissue application seeking to add the non-elected claims. *In re Watkinson*, 900 F.2d at 231, 14 USPQ2d at 1408.

The present case is different from *In re Orita* and *In re Watkinson* because we determined that the subject matter of claims 188 and 189 is not necessarily substantially identical to non-elected claim 28.⁶

In *Doyle* the situation was held to be different from those of the applicants in *In re Orita* and *In re Watkinson*. *Doyle* involved whether failure to present a so-called linking claim, a claim broad enough to read on or link two or more groups of cancelled, non-elected claims as well as elected claims is an error correctable by reissue. *Doyle's* reissue application claims were directed to a genus that read on, and were substantially broader than, the claims found in the issued patent. The court reasoned that *Doyle* was

⁶ If we determined that there was evidence to show that the subject matter of claims 188 and 189 was substantially identical to non-elected claim 28, the estoppel rationale underlying *In re Orita* and *In re Watkinson* would apply. In these cases, the applicant explicitly agreed to the requirement of independent prosecution of the disputed claims (or claims substantially similar to the disputed claims) in a divisional, and not as a part of the application directed toward the elected group. When the applicants returned in reissue seeking to add the disputed claims, our reviewing court held them to the terms of their original agreements.

seeking a broadening reissue of his original patent to cover material that he invented and disclosed, but inadvertently failed to claim in his issued patent. The court also stated that these claims could have been prosecuted with the claims of the elected group. *In re Doyle*, F.3d at 1360, 63 USPQ2d at 1165.

The present case is different from *In re Doyle*. The Appellants in the original application presented claim 28 directed to a calcined mesoporous silica film on a substrate which was a non-elected invention. Appellants acquiesced to the restriction and divisional applications were never filed. The presentation of claims 188 and 189 directed to a product is not an extension of the method claims of the original patent as argued by Appellants, but would have been grouped with the non-elected product claims as further discussed below. Thus, these claims would never have been examined in the original application.

As the subject matter of claims 188 and 189 is not necessarily substantially identical to non-elected claim 28, the factual situation of *In re Weiler* is closer to the facts of the present case than Orita.

In *Weiler* the applicant was estopped from filing for an invention based on his failure to file a divisional application. The examiner in *Weiler* imposed a three-way restriction requirement. Weiler made an election, but failed to file divisional applications to assert the non-elected groups. *Weiler* at 1578, 229 USPQ at 674. Following the issuance of his patent on the elected claims, he filed a reissue application asserting new claims. Weiler appealed the Board's affirmance of two claims (13 and 19)

because they were directed to subject matter not claimed at all in the original application.⁷ The Weiler court stated “[t]he subject matter of claims 13 and 19 are clearly independent of and distinct from each other, from that of elected claims 1-7, from that of non-elected organic compound claims 8 and 11, and from that of non-elected protein compound claims 9 and 10. Weiler would thus have had no right to insert and present claims 13 and 19 in the original application after the examiner's requirement for restriction.” *Weiler* at 1580, 229 USPQ at 675. The court affirmed the rejection of claims 13 and 19 stating “Weiler's failure to have ever claimed, broadly or narrowly or otherwise, the subject matter of claims 13 and 19, and his failure to show an ‘intent to claim’ that subject matter, indicated absence of the statutorily required ‘error.’” *Id.* The court also determined that Weiler's new claims asserted a completely separate invention from the issued claims or any of the non-elected claims. *Weiler* at 1581, 229 USPQ at 676. Thus, because claims 13 and 19 claimed a distinct invention from the issued claims, they too would have been subject to the original restriction requirement and the applicant would not have been allowed to prosecute them with the original patent. *Weiler* at 1581, 229 USPQ at 676. Thus, the *Weiler* doctrine applies to an attempt to assert new claims in reissue that read on a separate invention and not on the subject matter of the issued patent claims.

⁷ Weiler also filed other claims, 14-18, that were not appealed from the Board's affirmance of the Examiner's rejection.

As stated above, the court in *Bridgeford* established that where the product is defined by setting forth the process by which it is made, the invention so defined is a product and not a process. Thus, the subject matter of claims 188 and 189 is directed to a product distinct from the product of claim 28 and distinct from the process claims of the original patent because the product can be made by a materially different process such as chemical vapor deposition (CVD) followed by calcination. See MPEP §806.05(f). In other words, the subject matter of claims 188 and 189 is directed to an invention distinct from that of the issued claims of the original patent and distinct from the non-elected claims. Thus, the subject matter of claims 188 and 189 is not a linking claim that read on the elected claims, as in *In re Doyle*, and could not have been asserted with, the elected group. Therefore, the entire premise of *Weiler* would apply to this situation, for *Weiler* applies to an attempt to assert new claims in reissue that read on a separate invention and not on the subject matter of the issued patent claims.

CONCLUSION

For the foregoing reasons and those set forth in the Answer, based on the totality of the record, we determine that the preponderance of evidence weighs in favor of the Examiner's position, giving due weight to Appellants' arguments. Accordingly, the Examiner's rejection of claims 188 and 189 under 35 U.S.C. § 251 for failing to specify an error correctable by reissue is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(iv)(effective Sep. 13, 2004; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat. Office 21 (Sep. 7, 2004)).

AFFIRMED


JEFFREY T. SMITH
Administrative Patent Judge

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